

REMARKS

The Office Action mailed on April 22, 2010 has been reviewed and the comments of the Examiner carefully considered. Claims 1, 20 and 21 have been amended herein. Support for the amendments may be found in the originally filed claims and the specification. Claims 1-5, 7-13, 20 and 21 are pending and currently stand rejected.

Rejections under 35 U.S.C. § 102(e)

Claims 1-5, 7, 11, 13, 20 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Canada et al. (U.S. Patent No. 7,118,761). Applicants respectfully traverse the rejection and submit that the claims are not anticipated for the following reasons.

It is well-settled that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and also MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil C. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ...claim” *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, Canada must describe each and every element of claims 1-5, 7, 11, 13, 20 and 21 in order to anticipate these claims under section 102(e). However, Canada does not meet this burden, because Canada does not teach or describe all of the claim limitations.

While not in agreement with the basis for the rejection, but for the sake of advancing prosecution, Applicants have amended claims 1, 20 and 21 herein to recite that the anionic polymer complexed with the Ag⁺ is an anionic polycarboxylate polymer. These amendments are supported throughout the as-filed specification.

The Office Action alleges that Canada teaches a silver salt “which is a complex of Ag⁺ and an anionic polymer” at lines 21-42 of column 8, and that the resins taught by Canada anticipate the anionic polymer claimed. However, as set forth above, claims 1, 20 and 21 have been amended to recite that the anionic polymer is a polycarboxylate polymer. No anionic polycarboxylate polymer is taught by Canada, neither in the cited passage, nor anywhere else in

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the patent. Nor is any anionic polymer taught by Canada. Canada teaches only ion-exchange resins, zeolites, and substituted glass compounds. Canada does not disclose an anionic polycarboxylate polymer. Canada goes on to exemplify sodium hydrogen zirconium phosphate, as well as calcium phosphate, as examples of silver ion containing compounds of the patent.

Further highlighting the fact that Canada does not disclose a complex of Ag^+ and an anionic polycarboxylate polymer, it is noted that Canada does not refer to polymers in any manner in connection with the passage cited in the Office Action, despite the fact that Canada refers to polymers elsewhere in the body of the patent.

Additionally, Canada does not disclose or suggest a dyestuff that is a silver salt photostabilizer. The mere mention of dyes, in general, in the Canada patent does not provide any guidance as to which dyes may or may not have any particular properties. This is particularly so, because the Canada patent discloses dyes separately from any discussion of antioxidants.

Therefore, as Canada et al. does not teach, suggest, or otherwise disclose a complex of Ag^+ and an anionic carboxylate polymer, nor a dyestuff that is a silver salt photostabilizer, Canada does not teach each and every element of Applicants' claims. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claim 1, as amended, and claims 20 and 21 are in condition for allowance, and further that claims 2-5, 7, 11, and 13 are thereby allowable as written as depending from an allowable independent claim.

Rejections under 35 U.S.C. § 103

- 1. Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Canada et al., in view of Camden et al. (US 6,136,835).**

The test which must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

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Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103 ...

[T]he four factual inquires enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations. (MPEP § 2141).

When applying 35 U.S.C. § 103, the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. MPEP § 2141 II. The cited references do not satisfy this required burden to establish a finding of obviousness.

Applicants respectfully submit that claims 8-10 are allowable as depending from an allowable independent claim for the reasons stated above. Canada does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polycarboxylate polymer, nor a dyestuff that is a silver salt photostabilizer. Camden does not cure the deficiency of Canada, as Camden also does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polycarboxylate polymer, nor a dyestuff that is a silver salt photostabilizer. The mere mention of dyes, in general, in the Canada patent does not provide any guidance as to which dyes may or may not have any particular properties. This is particularly so, because the Canada patent discloses dyes separately from the discussion of antioxidants. The Camden reference does not provide any motivation missing from the Canada reference, because Camden provides no disclosure or suggestion of a dyestuff as an antioxidant.

Accordingly, this combination of references does not provide any guidance or motivation for the skilled artisan to arrive at the claimed invention, and as a result, the skilled artisan would have no reasonable expectation of success in arriving at the claimed invention. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claims 8-10 are in condition for allowance.

2. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Canada et al., in view of Hirsch (US 1,962,900).

Applicants respectfully submit that 12 is allowable as depending from an allowable independent claim for the reasons stated above. However, for the sake of completeness, applicants submit that the rejection of 12 under 35 U.S.C. § 103(a) as being unpatentable over Canada et al. in view of Hirsch is improper for the following reasons. Hirsch does not cure the deficiency of Canada, as Hirsch does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polycarboxylate polymer, nor a dyestuff that is a silver salt photostabilizer.

Accordingly, this combination of references does not provide any guidance or motivation for the skilled artisan to arrive at the claimed invention, and as a result, the skilled artisan would have no reasonable expectation of success in arriving at the claimed invention. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claim 12 is in condition for allowance.

Summary

Applicants respectfully submit that the claims are in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5809 to clarify any unresolved issues raised by this response.

The Director is hereby authorized to charge/credit Deposit Account No. **50-0310** (Billing No. 101713-5041) for any other required fees, deficiencies or overpayments in connection with this Response.

Respectfully submitted,

DEBORAH ADDISON ET AL.

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By: /Thomas M. Sossong Jr./
Thomas M. Sossong, Jr., Ph.D.
Registration No. **48,463**
MORGAN, LEWIS & BOCKIUS LLP
1701 Market Street
Philadelphia, PA 19103-2921
Telephone: (215) 963-5809
Facsimile: (215) 963-5001
E-Mail: tsossong@morganlewis.com